

Human Genome Sciences, Inc.

v.

Amgen, Inc. et al.

LETTER BRIEF REGARDING ISSUES ON APPEAL

EXHIBIT G

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The opinion in support of the decision being entered today is not binding
precedent of the Board

Paper 113

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Richard E. Schafer)

Human Genome Sciences, Inc.,

Junior Party

(Application 10/005,842-IFW

Inventors: Jian Ni, Reiner L. Gentz,
Guo-Liang Yu and Craig A. Rosen),

v.

Immunex Corp.,

Senior Party

(Patent 6,642,358

Inventors: Charles Rauch and Henning Walczak).

Patent Interference No. 105,381 (RES)

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, and
FRED E. MCKELVEY, *Senior Administrative Patent Judge*, and RICHARD
E. SCHAFER, ADRIENE LEPIANE HANLON and CAROL A. SPIEGEL,
Administrative Patent Judges.

SCHAFFER, *Administrative Patent Judge*.

Decision - Rehearing - Bd.R. 125(c)

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1 Human Genome Sciences (HGS) requests reconsideration of the part
2 of the panel decision entered March 27, 2007 (Paper 101) holding HGS'
3 involved claims unpatentable under 35 U.S.C. § 102(e). HGS asserts that
4 the motion should have been deferred rather than decided on the merits. We
5 deny the request.

6 **Background**

7 **Interference Procedure**

8 Interferences are typically conducted in two phases: a first phase,
9 often referred to as the "motions phase," and a second phase, the "priority
10 phase." During the first phase adjustments may be made to the initial
11 conditions of the interference by filing certain motions. These motions
12 include, but are not limited to, challenging (1) the existence of the
13 interference (no interference-in-fact), (2) the appropriateness of the count or
14 counts (add or substitute counts), (3) the claims at risk in the interference
15 (claim correspondence), (4) the patentability of involved claims, and (5) the
16 constructive reduction to practice date of the subject matter of the count
17 (according or attacking priority benefit).

18 The first phase concludes with a decision on motions. The decision
19 sets the conditions of the interference for the priority phase. These
20 conditions include the count or counts (which govern the scope of the proofs
21 which may be submitted to prove priority), the dates which the junior party
22 must prove in order to prevail on priority, and the claims which will be lost
23 in the event of an adverse judgment on priority.

24 During the priority phase, the parties attempt to prove priority in the
25 context of the conditions established as a result of the motions phase. The
26 parties may attempt to prove an earlier actual reduction to practice, an earlier

1 conception of the invention coupled with diligence to a later reduction to
 2 practice, and/or derivation.

3 **Prosecution of Interference 105,381**

4 During the first stage of the interference, the parties filed a number of
 5 motions.

6 HGS' motions included a motion asserting that it was entitled to an
 7 earlier constructive reduction to practice date for the subject matter of the
 8 count. HGS Motion 2, Paper 30. HGS there asserted a constructive
 9 reduction to practice by the filing of Provisional Application 60/040,846 and
 10 further asserted that it should be accorded the filing date of that application
 11 as to the subject matter of the count.

12 Immunex's motions included a motion asserting, *inter alia*, that HGS'
 13 involved claims were anticipated by certain prior art under 35 U.S.C.
 14 § 102(e). Immunex Motion 3, Paper 36. In addition to arguing that HGS'
 15 claimed subject matter read on the prior art, Immunex argued that HGS'
 16 claimed subject matter was not entitled to the filing date of HGS' 846
 17 Provisional Application. Immunex relied upon both documentary and
 18 testimonial evidence supporting its position. After cross-examining
 19 Immunex's witnesses, HGS filed an opposition. Paper 49. The opposition
 20 included the argument that HGS' involved claims were not anticipated
 21 because those claims were said to be entitled to the filing date of the 846
 22 provisional. HGS supported its opposition with both documentary and
 23 testimonial evidence, including the cross-examination testimony of
 24 Immunex's witnesses. After cross-examination of HGS' witness, Immunex
 25 filed a reply. Paper 66. The reply relied upon testimonial and documentary
 26 evidence. Immunex's reply again argued that HGS' claims were not entitled
 27 to the filing date of the 846 provisional.

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1 The parties appeared for oral argument where both parties addressed
 2 Immunex's Motion 3. During his rebuttal period at oral argument, HGS'
 3 counsel requested for the first time in the interference that, in the event that
 4 HGS was held not to be entitled to the benefit of the earlier application, the
 5 decision on Immunex's Motion 3 be deferred until the priority phase of the
 6 interference:

7 It is not late today, for example, to ask you to -- if the
 8 benefit motions don't resolve 102[(a)] and 102[(e)] and
 9 moot it, which we believe it will, because we are entitled
 10 to '846, that you defer the 102[(a)] and 102[(e)] motions
 11 in all these interferences to priority

12 Oral Argument Transcript, Paper 99, p. 5, ll. 11-16. HGS relied upon
 13 *LaVeen v. Edwards*, 57 USPQ2d 1416 (BPAI 2000), as supposedly allowing
 14 such deferral. Oral Argument Transcript, Paper 99, p. 5, ll. 2-10.

15 Subsequently, the panel issued a decision granting Immunex's
 16 Motion 3 to the extent that HGS' involved claims were anticipated under 35
 17 U.S.C. § 102(e). Paper 101, p. 29-38. In reaching its decision the panel also
 18 held that HGS' claimed subject matter was not entitled under 35 U.S.C.
 19 § 119 to the filing date of the **846** provisional application. Paper 101, p. 29-
 20 38. The panel decision also denied HGS' motion for the priority benefit of
 21 the filing date of the provisional application as to the subject matter of the
 22 count. Paper 101, p. 7-28. The opinion did not address the request to defer
 23 the decision on the motion.

24 **Discussion**

25 HGS requests reconsideration arguing that the panel overlooked HGS'
 26 request during the oral argument that a decision on Immunex's Motion 3 be
 27 deferred to the priority phase of the interference under the *LaVeen* decision.
 28 Paper 104, p. 1.

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1 **LaVeen v. Edwards**

2 *Laveen* is an expanded panel decision and binding precedent of the
 3 Trial Division. During the motions phase Edwards filed a motion seeking
 4 entry of judgment against certain of Leveen's claims asserting that the
 5 subject matter of those claims is anticipated or would have been obvious.
 6 Both grounds relied upon a patent said to qualify as prior art under § 102(e).
 7 In opposing the motion, LaVeen relied on allegations in its preliminary
 8 statement which asserted an actual reduction to practice prior to the filing
 9 date of the reference patent and asked that the motion be deferred until final
 10 hearing.

11 The *Laveen* opinion noted that the PTO's regulations did not
 12 specifically cover the use of a preliminary statement as a "defense" or
 13 opposition to a motion alleging unpatentability under § 102(a) or § 102(e)
 14 prior art. The opinion confirmed a practice directed to situations where (1) a
 15 motion for judgment relies upon a § 102(a) or § 102(e) reference and (2) the
 16 opponent alleges a date of invention in its priority statement earlier than the
 17 prior art date of the reference. Under this practice the opponent had to make
 18 a litigation choice and elect one of two choices:

19 A first choice will be for the opponent to call attention to
 20 its preliminary statement and ask that a decision on the
 21 preliminary motion be deferred to the priority phase of the
 22 interference. In effect, LeVeen has asked for this choice in its
 23 opposition in this interference.

24 A second choice is for the opponent to present proofs
 25 under 37 CFR § 1.131 together with its opposition.

26 *Laveen*, 57 USPQ2d at 1420.

27 There are similarities in antedating under § 1.131 and proving priority
 28 under 35 U.S.C. § 102(g). The proofs under § 1.131 must "establish
 29 reduction to practice prior to the effective date of the reference, or

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1 conception of the invention prior to the effective date of the reference
2 coupled with due diligence from prior to said date to a subsequent reduction
3 to practice or to the filing of the application.” 37 CFR § 1.131(b). Section
4 102(g) similarly provides: “In determining priority of invention under this
5 subsection, there shall be considered not only the respective dates of
6 conception and reduction to practice of the invention, but also the reasonable
7 diligence of one who was first to conceive and last to reduce to practice,
8 from a time prior to conception by the other.”

9 As a result of these similarities, it may be that some of the proofs for
10 antedating and priority are the same. For example, an inventor’s notebook
11 and inventor’s testimony as to an actual reduction to practice might be relied
12 upon for both antedating and priority. Deferral of a decision on the
13 unpatentability motion until the priority phase would avoid filing of separate
14 declarations by the inventor, one in each phase, on antedating and on priority
15 and having the inventor cross-examined separately on each declaration.
16 Thus, deferral of the decision until the priority phase may be less costly and
17 more efficient for the parties and the Board.

18 *LaVeen* confirms the practice that an opponent may request deferral of
19 the decision on the unpatentability motion in lieu of putting on a § 1.131
20 case during the first phase of the interference. While *LaVeen* speaks in
21 terms of deferral of the motion decision, an opponent is also requesting
22 deferral of the submission of its evidence and arguments supporting
23 antedating until the priority phase. In other words, if the request for deferral
24 is granted, the opponent’s evidence and arguments on antedating will be
25 submitted simultaneously with the opponent’s priority case. The movant’s
26 reply will also be submitted during the priority phase.

1 **HGS' Request for Reconsideration**

2 HGS, quotes from Footnote 9 of the *LaVeen* opinion, that “[t]here
 3 may be other choices which might make sense in a particular case.” HGS
 4 urges that the *LaVeen* procedure should be extended to situations where the
 5 opponent attempts to “antedate” by relying on the filing dates of earlier
 6 applications under 35 U.S.C. §§ 119 and 120.

7 We decline to extend the *LaVeen* practice to this fact situation. As we
 8 noted above, a foundation of the *LaVeen* practice is the possible similarity of
 9 antedating and priority proofs. Where antedating and priority proofs and
 10 arguments overlap, deferral of the decision and submission of evidence until
 11 the priority phase may result in a more efficient and less costly proceeding.
 12 *See* 37 CFR § 41.1(b) (“The provisions of Part 41 shall be construed to
 13 secure the just, speedy, and inexpensive resolution of every proceeding
 14 before the Board.”) HGS has not explained, and we do not perceive, any
 15 similar benefits from a deferral of the decision on patentability where the
 16 opposition relies on the filing dates of earlier applications under §§ 119 and
 17 120. Unlike antedating under § 1.131 and priority, which involve similar
 18 considerations, there are no readily apparent similarities between proofs and
 19 arguments attempting to establish an earlier effective filing date, on the one
 20 hand, and priority proofs and arguments, on the other.

21 We also note that considerations involved with an opposition asserting
 22 that the claims are entitled to an earlier effective filing date under §§ 119
 23 and 120 may be similar to those involved in a motion asserting that the
 24 subject matter of a count should be accorded the benefit of the filing date of
 25 an earlier application. For example, some proofs and testimony for the
 26 former may overlap the proofs and testimony for the latter. Thus, both
 27 should be decided in the same phase of the interference. Experience has

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1 shown that the conduct of an interference is most efficient when the motions
 2 are decided in the first phase of the interference. There are no readily
 3 apparent efficiencies resulting from deciding a motion for benefit while
 4 deferring a decision on an unpatentability motion defended using
 5 overlapping proofs and arguments.¹

6 **Time for Requesting Deferral under *LaVeen***

7 HGS raised deferral of the motion during the rebuttal portion of its
 8 oral argument. HGS' request was untimely.

9 As noted in the *LaVeen* opinion, a party faced with an unpatentability
 10 motion relying on § 102(a) or (e) prior art has two choices. In simplified
 11 form the two choices are (1) request deferral or (2) file an opposition.
 12 *LaVeen*, 57 USPQ2d at 1420. HGS filed an opposition. Thus, to the extent
 13 that *LaVeen* had any applicability, HGS made its choice by filing an
 14 opposition to Immunex's Motion 3. At this point the issue was joined and
 15 there was no apparent reason to defer the decision to the priority phase.
 16 Having made this litigation choice, HGS, in effect, is now requesting a
 17 second opportunity to antedate relying on what apparently would be § 1.131
 18 antedating proofs. As stated in *LeVeen*, 57 USPQ2d at 1415,

19 because there are adverse parties in an interference, a
 20 party is normally given but one opportunity to make out
 21 its case. *Compare Burson v. Carmichael*, 731 F.2d 849,
 22 854, 221 USPQ 664, 667 (Fed. Cir. 1984) (in an

¹ There are apparent detriments. For example, denying a motion for priority benefit while deferring the opposition, reply and decision on the patentability motion would be unfair to the moving party and probably increase costs. Having received a decision on a companion motion having very similar issues and overlapping proofs, the opponent of the deferred patentability motion would likely reform its opposition with new arguments and proofs attempting to address any deficiencies noted in the earlier decision.

interference case where losing party wanted a remand to place additional evidence in the record, the Federal Circuit notes that "There is no support in the law for repeated bites at the apple.").

5 We also note that Immunex’s unpatentability motion was fully
6 developed and ripe for decision. The parties had presented testimony and
7 documentary evidence, cross-examined the witnesses and fully briefed the
8 patentability issue. Thus, HGS had a full opportunity to address the
9 unpatentability issue. There was no reason to defer the decision. It was
10 appropriate to decide the motion. *Perkins v. Kwon*, 886 F.2d 325, 328, 12
11 USPQ2d 1308, 1311(Fed. Cir. 1989) (“[I]ssues of patentability and priority
12 that have been fully developed before the Board should be resolved by the
13 Board.”).

14 Where a movant has filed an unpatentability motion relying on
15 § 102(a) or (e) prior art and the opponent has alleged a date of invention in
16 its priority statement earlier than the date of the prior art, the time for
17 requesting deferral of the decision is no later than the time for filing an
18 opposition to the motion. The opponent will then have all the information
19 necessary to decide whether to oppose by putting on a § 1.131-type case or
20 to request deferral. Since the deferral is discretionary with the APJ
21 designated to handle the interference, the matter should initially be raised in
22 a conference call with that APJ prior to the time for filing an opposition.

1

DECISION

2

HGS' request for reconsideration is denied.

/ss/ Michael R. Fleming)
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